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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY B. PEARSON
and J. BRADLEY BRIDGES

Appeal 2008-0021
Application 10/668,686¹
Technology Center 2600

Decided: July 11, 2008

Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed September 23, 2003. The real party in interest is SBC Knowledge Ventures, L.P.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-11, 13-27, 29-36, and 42.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to location-based call routing and call answering. (Spec. paragraph [0001].)

Claims 1, 13, and 23 are exemplary:

1. A method of processing a call, the method comprising:

receiving location data via an interconnected network, the location data derived from a proximity sensor, the proximity sensor configured to provide a proximity determination with respect to a mobile device of a subscriber and the proximity sensor;

sorting a list of a plurality of addresses identifying communication devices of the subscriber based on the location data;

receiving a first call at a primary destination address associated with the subscriber;

selecting a first address from the sorted list of the plurality of addresses, the selected address identifying a

² Claims 12 and 28 have been canceled and claims 37-41 have been withdrawn from consideration.

communication device of the subscriber proximate to the proximity sensor.

13. A method to update a proximity zone state, the method comprising:

receiving location data via an interconnected network, the location data derived from a proximity sensor, the proximity sensor configured to provide a proximity determination with respect to a mobile device of a subscriber and the proximity sensor;

detecting a change in subscriber location based on the location data;

determining a change from a first proximity zone state to a second proximity zone state based on the subscriber location; and

updating a data record utilizing the location data, the data record accessible to a call redirection control system, the data record including a proximity zone field, the proximity zone field changed from a first proximity zone state to a second proximity zone state, the data record further including an ordered list of addresses of the subscriber, the ordered list of addresses reordered based on the changed proximity zone field.

23. A system for manipulating call redirection, the system comprising:

a proximity sensor configured to determine whether a mobile device is proximate to the proximity sensor, wherein the proximity sensor is a charging cradle, the charging cradle configured to provide energy to a battery within the mobile device when the mobile device is positioned in the cradle;

computational circuitry coupled to the proximity sensor, the proximity sensor configured to communicate data to the computational circuitry, the data associated with a proximity determination with respect to the mobile device and the proximity sensor; and

an interconnected network access point to a computer network coupled to the computational circuitry to transmit a call redirection control message via the interconnected network access point in response to the proximity determination.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Davidson	US 4,932,050	Jun. 5, 1990
Theimer	US 5,603,054	Feb. 11, 1997
Goss	US 6,320,534 B1	Nov. 20, 2001
Gross	US 6,389,117 B1	May 14, 2002

Claims 1-5, 9-11, 13-19, 23-26, 29, 31-33, and 42 stand rejected under 35 U.S.C. § 103(a) as being obvious over Davidson and Goss.

Claims 6-8 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being obvious over Davidson, Goss, and Gross.

Claims 27, 30, and 34-36 stand rejected under 35 U.S.C. § 103(a) as being obvious over Davidson, Goss, and Theimer.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have

not been considered and are deemed to be waived. *See* 37 C.F.R.
§ 41.37(c)(1)(vii).³

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Davidson and Goss disclose or would have suggested sorting a list of a plurality of addresses identifying communication devices of a subscriber based on location data, an ordered list of addresses being reordered based on a changed proximity zone field in a data record, and a proximity sensor that is a charging cradle, and also whether the teachings of Davidson and Goss properly may be combined.

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence

³ Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). "To

facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* The Supreme Court noted that "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. The Court also noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 1742. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

In *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007), the Federal Circuit concluded that it would have been obvious to combine (1) a mechanical device using a phonograph to play sounds associated with a letter of a word imprinted on a puzzle piece with (2) a modern microprocessor-based device to produce the sound associated with the first letter of a word in a book inserted in the device. The claimed combination was "an old idea or invention . . . using newer technology that is commonly available and understood in the art." *Id.* at 1162. The Federal Circuit reasoned that "[a]ccommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children's learning devices." *Id.* at 1161.

In reaching its conclusion, the Federal Circuit recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Id.* at 1161 (citing *KSR*, 127 S. Ct. at 1739). Although the combination of prior art references lacked a "reader" to automatically identify the book inserted in the device, the Federal Circuit found no error in the District Court's determination that readers were well-known in the art at the time of the invention. *Leapfrog*, 485 F.3d at 1162. The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" nor had it presented any evidence that the inclusion of the reader "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-11, 13-27, 29-36, and 42 as being obvious. Reviewing the record before us, we do not agree. In particular, we find that the Appellants have not shown that the Examiner failed to make a prima facie showing of obviousness with respect to claims 1-11, 13-27, 29-36, and 42. Appellants failed to meet the burden of overcoming that prima facie showing.

§ 103 Rejection - Davidson / Goss

Appellants argue that the combination of Davidson and Goss is improper because the proposed modification to the references based on the combination would render them unsatisfactory for their intended purposes and because the references teach away from each other. (App. Br. 8-9; Reply Br. 2-3.) We do not agree.

Instead, we agree with the Examiner (Ans. 15-17) that Davidson and Goss properly may be combined. Davidson is directed to a system that uses proximity status of a telephone station user to route a telephone call to a location where there is a person present to answer. (Davidson Abstract; col. 1, l. 65 to col. 2, l. 3; col. 2, l. 8 to col. 3, l. 40.) Goss is directed to a system that keeps track of the location of a subscriber, sorts through a database of telephone numbers and corresponding locations to determine if any phones are within a specified proximity of the subscriber, and routes the call to a phone based upon the subscriber's proximity to the phone. (Goss Abstract; col. 1, l. 46 to col. 3, l. 8.) Thus, Davidson and Goss each are in the same field of endeavor.

We do not agree that combining the teachings of Goss regarding routing calls based on the subscriber's proximity to a phone with the system of Davidson would render the references unsuitable for their intended purpose. In particular, modifying Davidson in view of the teachings of Goss would not render the call routing system of Davidson unsuitable for its intended purpose of routing a call to a phone where a person is proximate to answer the call. Instead, modifying the system of Davidson with the teachings of Goss as articulated by the Examiner would enhance Davidson's ability to fulfill this purpose.

We also do not agree that Davidson teaches away from Goss. Davidson, filed ten years prior to Goss, states that a system which identifies an individual person is "very useful," (Davidson col. 1, ll. 53-54) but the cost and complexity of such a prior art system is "undesirable and unnecessary in many applications" (Davidson col. 1, ll. 54-60). Thus Davidson suggests the desirability of the combination by stating that a system which identifies an individual is "very useful." We agree with the Examiner (Ans. 16) that ten years of technological advancement between Davidson and Goss would have made the technology more affordable and more widely available.

In addition, although Davidson discusses increased cost and complexity of a system which identifies an individual, this does not "suggest[] that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant," *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994), and therefore does not teach away from the claimed invention -- especially in light of Davidson's teaching that it is "very useful" to have a system which identifies an individual. The combination of Davidson and Goss would have been no

more than the combination of familiar elements according to known methods with no unpredictable results. *See KSR*, 127 S. Ct. at 1739. There is no evidence that the combination would have been "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog*, 485 F.3d at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

Regarding independent claim 1, Appellants argue that neither Davidson nor Goss discloses or suggests "sorting a list of a plurality of addresses identifying communication devices of the subscriber based on the location data," as claimed. (App. Br. 5-6; Reply Br. 1.) We do not agree.

As the Examiner correctly found, Goss discloses the claimed feature of sorting a list of addresses identifying a subscriber's communication devices based on location by teaching a location based telephone routing system that searches a list of available phones and returns a result based on the physical location of the phones. (Ans. 3-4, 11-13; *see also* Goss Abstract; col. 1, ll. 6-10; col. 1, l. 46 to col. 3, l. 8; col. 3, ll. 43-50, 58-66; col. 4, ll. 7-10; col. 4, l. 56 to col. 5, l. 67; col. 6, ll. 18-34.) We agree with the Examiner (Ans. 12) that, under a broad but reasonable interpretation of the claim, sorting occurs by distinguishing telephones within a specified proximity (and returning those telephones in the result) from those that are not within the specified proximity (and are not returned in the result). This interpretation is not inconsistent with the Specification. Indeed, the originally-filed Specification does not use the terms "sorting" or "sort." We note that originally-filed claim 12 claims an "ordered list arranged in an order based on the location data" and paragraph [0011] of the originally-

filed Specification briefly mentions polling subscriber devices in a order based on proximity zone data.

In addition, under a broad but reasonable interpretation of the claim consistent with the Specification, Davidson also teaches sorting a list of addresses of communications devices of the subscriber based on location data. Specifically, Davidson discloses an embodiment where the location data (proximity status of an agent) is used to distribute a call to a subscriber (travel agency) by distinguishing, in a serial fashion, a telephone of the subscriber that does not have an agent present from a telephone of the subscriber that does have an agent present. (Davidson col. 2, ll. 60-64; col. 10, ll. 15-54; Fig. 9.) Davidson also discloses an embodiment where the location data (proximity of a secretary and backup secretary) is used to distribute a call to a subscriber (Sue Smith) by distinguishing, in a serial fashion, a telephone of the subscriber that does not have a secretary present from a telephone of the subscriber that does have a secretary present. (Davidson col. 2, ll. 46-59; col. 9, l. 50 to col. 10, l. 14; Fig. 8.)

Appellants further argue that neither Davidson nor Goss discloses or suggests "selecting a first address from the sorted list of the plurality of addresses," as claimed. (App. Br. 5-6.) However, as the Examiner correctly found (Ans. 3, 13), the combined references teach this feature because Goss teaches a sorted list (see discussion of Goss *supra*) and Davidson teaches selecting the first address from a list (Davidson col. 8, l. 8 to col. 9, l. 68). Furthermore, Davidson teaches a sorted list (see discussion of Davidson *supra*) in addition to selecting the first address from a list.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Claims 2, 3, 5-10, and 42 were not argued separately and fall together with claim 1.

With respect to dependent claims 4 and 11, Appellants briefly list the limitations recited by these claims and argue that neither Goss nor Davidson discloses or suggests these limitations. (App. Br. 9.) We do not agree. The Examiner explained (Ans. 4-5, 17) where the limitations of claims 4 and 11 are taught in Goss and Davidson. Appellants have not provided any arguments regarding the specific teachings of Goss and Davidson set forth by the Examiner, nor any additional arguments for claim 1, from which claims 4 and 11 ultimately depend.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 4 and 11 under 35 U.S.C. § 103(a), and will sustain the rejection for the reasons discussed with respect to independent claim 1.

Regarding independent claim 13, Appellants argue that neither Goss nor Davidson teaches or suggests a "data record further including an ordered list of addresses of the subscriber, the ordered list of addresses reordered based on the changed proximity zone field." (App. Br. 6-7; Reply Br. 1-2.) We do not agree.

Initially, we note that the limitation argued by Appellants is directed merely to the contents of a data record and, as such, is directed to nonfunctional descriptive material. Nonfunctional descriptive material carries no weight in the analysis of patentability over prior art applied by the Examiner. *Cf. In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994). Nonfunctional descriptive material cannot render nonobvious an invention

that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Even if we were to give weight to this limitation, we agree with the Examiner (Ans. 5, 13-14) that it is taught by Goss. Specifically, Goss teaches updating the location associated with a mobile phone and differentiates between mobile phones and non-mobile phones in the database so that the system is able to identify phones that require more frequent location update queries. (Goss col. 2, ll. 24-28, 63-67; col. 5, ll. 16-32; col. 6, ll. 18-34.) We agree with the Examiner (Ans. 14) that Goss is dynamically ordering and re-ordering the locations of mobile phones and non-mobile phones by distance relative to the subscriber's location in order to dynamically route an incoming call, and thus teaches or suggests the claimed limitation of an ordered list in a data record being reordered based on a changed proximity zone data field.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 13 under 35 U.S.C. § 103(a). Claims 14-22 were not argued separately and fall together with claim 13.

Regarding independent claim 23, Appellants argue that neither Davidson nor Goss teaches or suggests a proximity sensor that is a charging cradle for a mobile device, as claimed. (App. Br. 7-8; Reply Br. 2.) We do not agree.

Instead, we agree with the Examiner (Ans. 7, 14-15) that, by teaching a rotary phone with a proximity device, and teaching that the proximity

device is designed to be built into other equipment, Davidson suggests that the proximity device may be built into the base of a rotary phone and further suggests the claimed limitation of the proximity sensor being a charging cradle of a mobile device. There is no evidence that replacing a rotary phone base with a mobile phone charging cradle would be "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog*, 485 F.3d at 1162 (citing *KSR*, 127 S. Ct. at 1740-41). Instead, replacing the rotary phone base with a mobile phone charging cradle would be nothing more than "an old idea or invention . . . using newer technology that is commonly available and understood in the art." *Id.* at 1162.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 23 under 35 U.S.C. § 103(a). Claims 24-36 were not argued separately and fall together with claim 23.

§ 103 Rejection - Davidson / Goss / Gross

With respect to claims 6-8 and 20-22, Appellants reiterate the arguments discussed with respect to independent claims 1 and 13 and further argue that Gross does not cure the alleged deficiencies of Davidson and Goss. (App. Br. 10.) Because Appellants have not provided any arguments regarding Gross nor any additional arguments for claims 1 and 13, we will sustain the rejection for the reasons discussed with respect to independent claims 1 and 13, from which claims 6-8 and 20-22 depend.

§ 103 Rejection - Davidson / Goss / Theimer

With respect to claims 27, 30, and 34-36, Appellants reiterate the arguments discussed with respect to independent claim 23 and further argue that Theimer does not cure the alleged deficiencies of Davidson and Goss. (App. Br. 10-11.) Because Appellants have not provided any arguments regarding Theimer nor any additional arguments for claim 23, we will sustain the rejection for the reasons discussed with respect to independent claim 23, from which claims 27, 30, and 34-36 depend.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-11, 13-27, 29-36, and 42 under 35 U.S.C. § 103.

DECISION

The rejection of claims 1-11, 13-27, 29-36, and 42 for obviousness under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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TOLER LAW GROUP
8500 BLUFFSTONE COVE
SUITE A201
AUSTIN, TX 78759